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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,444	11/15/2000	James E. Fergen	28299/34088E	4876
26574	7590	02/13/2004	EXAMINER	
SCHIFF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473			ST CYR, DANIEL	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/713,444

Applicant(s)

FERGEN ET AL.

Examin r

Daniel St.Cyr

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 132-143, 145-152 and 183-212 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 132, 138, 139, 143-148, 150, 183-187, 191, 192, 194, 197-200, 204, 205 and 207-210 is/are rejected.
- 7) ☒ Claim(s) 133-136, 140-142, 149, 151, 152, 188-190, 193, 195, 196, 201-203, 206, 211, 212 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of the communication filed 11/05/03.

Claim Objections

2. Claims 133, 201, 207, and 208 are objected to because of the following informalities:

Claims 133 and 201, "a" before "loan" should be changed to --the--.

Claims 207 and 208, line 1 "182" should be --183--.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 132, 138, 139, 143, 145-148, 150, 183-187, 191, 192, 194, 197-200, 204, 205, 207-210 and 212 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al, US Patent No. 4,153,931, cited by the applicant in view of Swartz et al, US Patent No. 5,594,228.

Art Unit: 2876

Green et al disclose an automatic library control apparatus comprising: a pair of branch libraries 1 and 2 are shown connected over a plurality of telephone lines TL to a central site 3 housing the central control units. The local library branch 1 comprises a Check-In/Check-Out console 4, a Check-Out console 5, and an alpha-numeric input and output display unit 6; a branch controller 14 or 16 is used to code the input and output data and interfaces the I/O units to the computer; a modem 17 such as the Intertel Model 235, is provided to convert the digital data from the branch controller to an analog signal which is transmitted over the telephone lines TL; a second modem 18 is used at the central receiving site, the central site 3 includes a central processing unit 20, a communications controller 22, and modem 18, a line printer 23, and a series of on-line data files 24 and off-line files 25; an on-line files consist of a circulation file 31 which contains the patron identification number and the item number together with the date of the transaction, an overdue file 32 which contains the overdue item number and the number of overdue days, a reverse file 33 containing the reverse item number and the corresponding patron number, and expired file 34 which stores the expired patron's number together with the number of days the card has expired, a delinquent file 35 which contains the delinquent patron number and the amount owed by the delinquent account, and an auxiliary file 36 which is used for temporary data storage. The off-line files 25 comprise: a patron file 40 which contains the patron number and the name and address of the patron together with any fine accumulated from the overdue files of from returning damaged books, a statistical file 41 which stores the number of patrons and the total fines collected and may also be used for specialized statistical information needs, and an item file 42 which contains a complete inventory of items in the library system (see col. 4, line 15+; figures 1-4).

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Green et al fails to disclose or fairly suggest the type payment accepted by the terminal (i.e. credit, debit, smart cards) including some of the payment steps.

Swartz et al disclose a self-checkout point-of-transactions system including deactivatable electro-optically coded surveillance tags comprising: a card reader 170 for reading credit/smart/debit card 174 and suggest that the system could be applied in rental agency or library (see col. 11, lines 56-59).

In view of Swartz et al's teachings, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the system of Green et al to provide self-service and incorporating a card reader to allow patrons to pay for their transactions using credit, debit, and smart cards. Such modification would make the system more practical by providing more convenient means for patrons to pay for their transactions and would make the system more effective due to rapid payment processing, which would reduce peak waiting times and would free up counter staffs to concentrate on other library works. Therefore, it would have been an obvious extension as taught by Green et al.

Allowable Subject Matter

6. Claims 133-137, 140, 141, 142, 149, 151, 152, 188-190, 193, 195, 196, 201-203, 206, 211 and 212 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed 11/05/03 have been fully considered but they are not persuasive. (see examiner remarks).

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Remarks:

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to the applicant's argument that it would not have been obvious for an artisan to modify the terminal of green to accept credit/debit/cash card, the examiner respectfully disagrees. As it has been demonstrated in Swart et al, an ordinary artisan would recognize the benefit of accepting these type of payments. These type of payment would provide greater flexibility and would provide more convenience for the patrons. Furthermore, the types of payments are very well known in the art. Therefore, it would have been an obvious extension as taught by Green.

In response to the applicant's argument that Green teaches away from the claimed invention because of using an aid worker to accept cash payment, the examiner respectfully disagrees. It is common practice in the art for terminal to accept both cash and credit card. Additionally some the applicant's arguments, such as a display for displaying the customers' transactions fees, these limitations are obtained since the structure limitations are as recited, they just the steps required for processing the transactions, which, therefore, obvious. The applicant's arguments are not persuasive. Refer to the rejection above.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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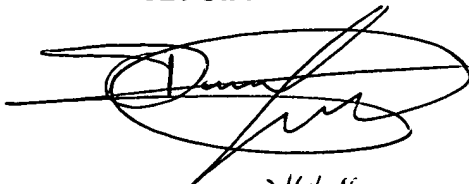
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 571-272-2407. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel St.Cyr
Primary Examiner
Art Unit 2876



2/6/04